

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHAO-HUA GUO, WEI WANG,
and DANIEL B. POURREAU

Appeal 2007-0381
Application 09/934,878
Technology Center 1600

Decided: April 30, 2007

Before CHARLES F. WARREN, PETER F. KRATZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

We remand the application to the jurisdiction of the Examiner and involved Technology Center for consideration of the Response to Supplemental Answer filed February 17, 2006. 37 C.F.R. §§ 41.35(b) and 41.50(a)(1) (2006).

A review of this Response (Reply) reveals that although the Board of Patent Appeals & Interferences (Board) is referred to in the remarks, the

substance of the remarks is seemingly directed to seeking reconsideration of the Examiner's decision not to enter Appellants' submission of excerpts from Principles of Polymerization by George Odium (Exhibit). The Reply does not present additional arguments addressing the merits of the Examiner's obviousness rejection. Rather, it is argued in the Reply that the Exhibit was submitted with an Amendment on September 25, 2003 and that the record reflects that the amendment (which allegedly included the Exhibit) was entered and considered by the Examiner. (*See Reply 2 and Supplemental Examiner's Answer 6*). Thus, the Reply is seemingly presenting a petitionable question that is not within the jurisdiction of this panel of the Board to resolve.

In particular, we note that the Supplemental Examiner's Answer informs Appellants of the non-entry status of the Exhibit without otherwise seeming to change the Examiner's position on appeal in the original Answer. Compare the Supplemental Examiner's Answer to the original Examiner's Answer in their entirety. Appellants' Reply to the Supplemental Examiner's Answer appears to be a Request for Reconsideration respecting the non-entry determination. In this regard, we observe that the possibility of a Supplemental Examiner's Answer, as referred to in the Panel Remand dated January 19, 2005, should have been reasonably understood by Appellants and the Examiner as being directed to the case where the Examiner may have determined that the Exhibit, in question, was entered and consideration thereof was required. In such a case, the Examiner was being advised to address such evidence and arguments pertaining thereto in a Supplemental Answer if the Exhibit was entered, found unpersuasive, and the rejections were being maintained. Of course, if the evidence had been entered and

considered by the Examiner in the Supplemental Examiner's Answer, Appellants would have been required to either request reopening of prosecution before the Examiner or file a Reply Brief to continue on Appeal.

In the instant case where the evidence currently remains non-entered, the Supplemental Answer appears to be a mislabeled Advisory Action informing Appellants of the entry status of the Exhibit without otherwise changing the preceding Answer (Supplemental Examiner's Answer 6). Appellants' Reply thereto appears to be a request for reconsideration of the non-entry determination.

We return this application to the jurisdiction of the involved Technology Center and the Examiner in order for the appropriate Office Official(s) to consider and prepare an appropriate response to the Reply filed February 17, 2006, and to otherwise clarify the record as may be necessary in light of the Supplemental Examiner's Answer, the Reply thereto, and the above.

This Remand is not for further consideration of a rejection unless the decision respecting the non-entry of the Exhibit allegedly accompanying an earlier filed amendment is changed; that is, the Exhibit is entered. If such a changed position as to the entry of the Exhibit is the ultimate outcome of this Remand; then, 37 C.F.R. § 41.50(a)(2) would apply. This is so because, in the latter case, the Examiner may submit another Supplemental Examiner's Answer maintaining the rejections and addressing the so entered Exhibit, Hence, a Reply Brief from Appellants would be required under such circumstances. 37 C.F.R. § 41.50(a)(2) (2006).

REMANDED

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